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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/699,626	10/30/2000	Daniel J. Sullivan	1001.1413102	7050

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[REDACTED] EXAMINER

MCCROSKEY, DAVID J

[REDACTED] ART UNIT

[REDACTED] PAPER NUMBER

3736

DATE MAILED: 07/29/2003

11

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application N .	Applicant(s)
	09/699,626	SULLIVAN, DANIEL J.
	Examin r	Art Unit
	David J. McCrosky	3736

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 21 August 2002.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.
- 4) Claim(s) 11-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 11-30 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4 1/2</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The final rejection mailed November 5, 2002 is withdrawn and replaced with the following non-final action.

The after final amendment received January 2, 2003 was not entered and as a result, the claims as presented in the amendment filed August 21, 2002 are pending.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 11, 12, 15-20, 23, 24 and 27-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Gambale et al (4,922,924 cited by Applicant). Gambale et al teach a guidewire for intravascular use (col. 1, ll. 5-9) having an elongate solid shaft (10). Figures 1 and 2 illustrate the solid nature using cross-hatching. The guidewire further comprises a proximal end (near element 10) and distal end (near element 22) with a

taper towards its distal end (12, col. 2, ll. 53-57), a radiopaque tip (18, col. 3, ll. 19 and 20) and a plurality of radiopaque markers defined by the individual coils of a coil (24) that have longitudinal spaces therebetween, they are longitudinally spaced with respect to each other and spaced with the nonradiopaque coil (30) (Figure 1 at area 12).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13, 14, 21, 22, 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gambale et al as applied to claims 11, 15, 23 and 24 above.

Gambale et al teach a guidewire as recited for claims 11, 15, 23 and 24. Gambale et al do not teach the dimensions of the longitudinal spaces or radiopaque markers.

Examiner notes that Applicant has not stated why the dimensions of the longitudinal spaces or radiopaque markers are critical. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the claimed dimensions since these dimensions were within the ordinary spacing and size used in the art. See also *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990) (Applicant must show criticality to rebut a *prima facie* case of obviousness).

Double Patenting

Claims 11-30 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 5-7, 9 and 10 of U.S. Patent

No. 6,179,788 to Sullivan (cited by Applicant). Although the conflicting claims are not identical, they are not patentably distinct from each other because Sullivan discloses a guidewire comprising an elongate shaft, a plurality of radiopaque sections and coils.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. McCrosky whose telephone number is 703-305-1331. The examiner can normally be reached on Mon-Fri 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max F. Hindenburg can be reached on 703-308-3130. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

DJM
July 23, 2003



CHARLES MARMOR
PRIMARY EXAMINER